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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,326	11/23/2001	Anthony Derosé	PT-1475000	2546

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EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/990,326	Applicant(s) DEROSE, ANTHONY	
	Examiner Joanne Silbermann	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,12-15 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,12-15,21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 6, 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. US #5,743,616 in view of Volland, US #4,965,701.

3. Giuliano et al. teach an ornament comprising body panel 10 made of plastic having sides and an etched surface, 10a, with a design, 12 (Figures 1 and 2). This design may be any non-random image (column 2 line 22). Opening 11 in one side of the body holds light emitting diode 1 by means of transparent material 2. A plurality of light sources may be used. The body panels may be colored and may include a mirrored surface.

4. The display of Giuliano et al. is decorative in that it is described as "design art" (column 1 line 45) and "an art rendering" (column 2 line 21). The artwork or rendering is considered to be a symbol and may be for a holiday or Christmas.

5. Giuliano et al do not teach the specific method by which the article is made, however the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

6. Giuliano et al. do not teach a string of ornaments, however Volland teaches string 14 of ornaments 15. The ornaments can be different sizes or shapes (Figure 6). As

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shown in Figure 7, like ornaments are strung together. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize a string of ornaments (as taught by Volland) to provide a larger, more aesthetically pleasing display.

7. Regarding claim 6, Giuliano et al. do not teach the specific materials recited in the claim, however it would have been obvious to one having ordinary skill in the art to utilize such materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Volland as applied to claims 1 and 12 above, and further in view of Ming-ho, US #5,217,286.

9. Giuliano et al. do not specifically teach a Christmas ornament, etc. however Ming-ho teaches a variety of ornaments and structures, as discussed in column 14 lines 37-53. It would have been obvious to one of ordinary skill in the art to utilize any well-known shape or ornament to serve the user's particular purpose. Additionally, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re SEID*, 73 USPQ 431 (CCPA 1947).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Volland as applied to claim 12 above, and further in view of Dimmick, US #5,151,679.

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11. Giuliano et al. and Voland do not teach the secondary light scattering elements as being shavings or bubbles, however this is well known in the art as taught by Dimmick. Dimmick teaches an illuminated sign including light scattering means comprising bubbles (column 4 lines 67-68). It would have been obvious to one of ordinary skill in the art to utilize bubbles as a light scattering means (as shown by Dimmick) to provide additional, increased illumination for the display.

Response to Arguments

12. Applicant's arguments filed 21 December 2006 have been fully considered but they are not persuasive.

13. Applicant argues that the ornament of Giuliano is thin and conformable, and the instant invention is not limited by such requirements, however no language in the claims supports this. The limitation that the ornament be shaped like a pine cone does not read over the Giuliano reference. Applicant also states that the ornaments of Giuliano are not three dimensional, however all articles are three dimensional.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
26 February 2007